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08/963656

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/963,656	11/03/97	GERARD	C LKS9405A2Z
			EXAMINER
HM11/0914			
DAVID E BROOK HAMILTON BROOK SMITH & REYNOLDS TWO MILITIA DRIVE LEXINGTON MA 02173			RABIN, E ART UNIT PAPER NUMBER
			7 1644
DATE MAILED: 09/14/98			

This is a communication from the examiner in charge of your application.  
**COMMISSIONER OF PATENTS AND TRADEMARKS**

## OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 11/3/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire       0       month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### **Disposition of Claims**

Claim(s) 38, 39 and 49-67 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) \_\_\_\_\_ is/are rejected.  
 Claim(s) \_\_\_\_\_ is/are objected to.  
 Claim(s) 38, 39, and 49-67 are subject to restriction or election requirement.

## Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CE

All  Some  None of the CERTIFIED CO

Received in this National

Certified copies not received: \_\_\_\_\_

## Acknowledgments

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

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~~COVER SHEET~~ SEE OFFICE ACTION ON THE FOLLOWING PAGES..

ANS 200-1800-101-00000000

### **DETAILED ACTION**

1. Effective February 7, 1998, the location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Technology Center 1600.
  
2. Claims 1-37 and 40-48 have been canceled. Claims 53-67 have been added. Claims 38, 39, and 49-67 are pending.

#### ***Election/Restriction***

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at [Donald.Adams@uspto.gov](mailto:Donald.Adams@uspto.gov) or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 38, 39, and 49-58, drawn to an antibody and a hybridoma cell line, classified in Class 530, subclass 388.22 and Class 435, subclasses 334 and 346.
  - II. Claims 59-60, drawn to a method of inhibiting chemokine receptor 3 function, classified in Class 435, subclasses 7.1 and 7.21.

- III. Claims 61-64, drawn to a method of treating an inflammatory disease or condition, classified in Class 424, subclass 143.1.
- IV. Claims 65-67, drawn to a method of detecting human chemokine receptor 3 protein, classified in Class 435, subclass 7.91 and Class 436, subclass 519.

4. The inventions are distinct, each from the other because of the following reasons:

- 5. Inventions II, III, and IV are unrelated methods. These inventions require different ingredients, process steps and endpoints to accomplish the use of inhibiting chemokine receptor 3 function, treating an inflammatory disease or condition, and detecting human chemokine receptor 3 protein. Therefore, they are patentably distinct.
- 6. Inventions I and II/III/IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antibody can be used to purify chemokine receptor 3 protein.
- 7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification in addition to their recognized divergent subject matter, and require different searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Applicant is further required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

If Group III is elected, Applicant is required to elect a *specific* disease or condition.

These species are distinct because their pathological conditions differ in etiology and therapeutic endpoints.

9. Applicant is required to elect a single disclosed species even though this requirement is traversed.

10. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

12. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable

over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

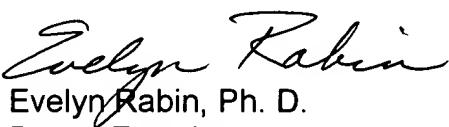
Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Rabin, Ph.D. whose telephone number is (703) 305-6811. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The FAX number for this Technology Center is (703) 305-3014 or (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

Evelyn Rabin, Ph.D.  
September 14, 1998

  
Evelyn Rabin, Ph. D.  
Patent Examiner  
Group 1640